

REMARKS

Claims 1, 2, 15, 22-24 and 27-36 are pending in this application; claim 1 is amended. Support for the amendments is found throughout the specification. Specific support for “nuclear membrane translocation protein” can be found, for example, on page 11, line 2, of the application. No new matter is added.

The claims, herewith and as originally filed, are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments and additions to the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

The Office Action requires an election under 35 U.S.C. § 121 from among the following groups:

- I. Claims 1-27, 32 and 34-36, drawn to conjugate of a transport protein and a polypeptide modulator of Notch signaling, classified in class 530, subclass 350; and
- II. Claims 1-31 and 33, drawn to conjugate comprising polynucleotide encoding a transport protein and a polypeptide modulator of Notch signaling, classified in class 536, subclass 23.1.

Applicants elect Group I, claims 1-27, 32 and 34-36 with traverse. The Office Action further required elections of a modulator of Notch signaling and a transport protein. Applicants elect, with traverse, “nuclear transmembrane translocation protein” and “Notch intracellular domain,” respectively. The claims are amended to reflect these elections.

Applicants’ understand that, upon the allowance of the product claims, process claims that depend from or contain all limitation of the product claims with be rejoined in accordance with MPEP § 821.04.

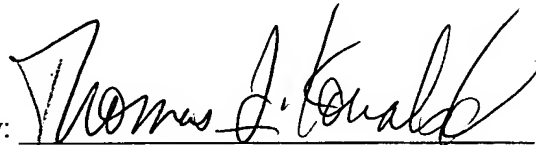
As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. (MPEP § 803) Second, searching the additional inventions must constitute an undue burden on the Examiner if restriction is not required. *Id.* In this instance, neither criterion has been met, as the inventions are not independent or distinct, nor would there be an undue burden in searching and examining the pending claims in one application.

Enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between all of the claimed combinations. Indeed, the search and examination of each combination is likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigates against restriction.

In view of the above, reconsideration and withdrawal of the Requirement for Restriction are requested, and an early action on the merits earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorney for Applicants

By: 

Thomas J. Kowalski
Reg. No. 32,147

Anne-Marie C. Yvon, Ph.D.
Reg. No. 52,390
(212) 588-0800